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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/640,780	08/18/2000	Jacques Dumas	BAYER8CI	7350

23599 7590 03/06/2002

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EXAMINER

ROBINSON, BINTA M

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 03/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/640,780

Applicant(s)

DUMAS ET AL.

Examiner

Binta M. Robinson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-77 is/are pending in the application.
- 4a) Of the above claim(s) 5-8, 10, 14, 17-42, 44 and 47-77 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 9, 11-13, 15, 16, 43 and 46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_

### **D tail d Action**

The examiner notes that the applicant traverses the restriction requirement at paper no. 10 asserting under MPEP §803 that "if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." The examiner, however, has not required election/restriction under MPEP 803.02. The examiner has restricted the application to a single, independent invention. If restriction was not applied, there would be a serious burden, because heteroaryl, or heterocyclic rings are classified in multiple classes of 546, 548, and 549. Applicants have failed to point out the supposed errors in the restriction requirement in order to be entitled to a request for reconsideration. Applicant's must point out supposed errors. Failure to do so is acquiescence. See MPEP 81803a.

The Markush objection of claims 1-4, 9, 11-16, 43, and 46 and the 112, second paragraph rejection of claims 43 and 46 are dropped in light of applicant's remarks at paper no. 10. The 112, second paragraph rejection of the phrase "cancerous cell growth mediated by raf kinase" has been withdrawn in light of applicant's remarks at paper no. 10. The examiner realizes that claim 14 was erroneously examined at paper no. 10 and should have been held nonelected since it is not drawn to the elected subject matter.

### **(old rejections)**

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact

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terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4, 9, 11-13, 15-16, 43 and 46 are rejected under 35 U.S.C. 112, first paragraph, for reasons of record at paper no. 9.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1-4, 9, and 11-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for reasons of record at paper no. 9.

### **Response to Applicant's Remarks**

#### **112, first paragraph rejection**

The applicant asserts that there is adequate disclosure within the specification for one skilled in the art to make the compounds recited in the claims and use them in accordance with the methods defined, without undue experimentation and that the burden is on the examiner to show otherwise. The examiner has recited the Wands factors. The claims are so broad that more than routine experimentation is required to place the invention in the possession of the public. The applicant does not provide working examples or test data for the compounds where B can equal all heteroaryl groups. What cancers, cell lines, what specific tests were performed to show that cancerous cell growth has been reduced in scope?

#### **112, second paragraph rejection**

The applicant asserts that the term "heteroaryl" is not ambiguous, and that one skilled in the art would clearly understand the scope and meaning of the term "heteroaryl" and the phrases, which contain this term. However, the examiner notes that the term heteroaryl includes rings yet to be discovered or synthesized. For example, 5 oxygen atoms or 5 atoms in one ring have not been made. In addition, such rings could include O, S, N, and Se with at least one carbon atom without the appropriate configuration of each atom. It doesn't stop there. "Heteroaryl" could include diffusion of additional heterocyclic ring systems or alternatively, the fusion with aromatic ring systems ranging from two rings on up to infinity – the problem is exacerbated when an alkyl group is attached thereto.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binta M. Robinson whose telephone number is (703) 306-5437. The examiner can normally be reached on M-F (9:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on (703)308-4698. The fax phone numbers for the organization where this application or proceeding is assigned are (703)308-7922 for regular communications and (703)308-7922 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0193.

BSMR  
3/4/02

*Alan L. Rotman*  
**ALAN L. ROTMAN**  
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